

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1, 2, 7, 8, and 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,958,576 to Komiya (hereinafter "Komiya"). Additionally, the Examiner rejects claims 1, 7, 8, 10, 17, 19, and 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,766,184 to Matsuno et al., (hereinafter "Matsuno"). Furthermore, the Examiner rejects claims 3, 6, 9, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Komiya. Still further, the Examiner rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Matsuno. Lastly, the Examiner rejects claims 11-13 and 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Komiya or Matsuno in view of U.S. Patent No. 5,135,489 to Jepson et al., (hereinafter "Jepson").

In response, Applicants respectfully traverse the Examiner's rejections at least with regard to claims 2 and 18 for at least the reasons set forth below. Thus, independent claims 1 and 17 have been amended to include the features of dependent claims 2 and 18, respectively, and claims 2 and 18 have been canceled. Claims 3 and 6 have been further amended to change their dependency from canceled claim 2 to amended claim 1. Furthermore, independent claims 21-24 have been amended to include limitations similar to that recited in dependent claims 2 and 18, namely, that "the operation wire and the coupling member are nondetachably connected."

The amendments to the claims are fully supported in the original disclosure, particularly in the claims themselves. Thus, no new matter has been entered into the disclosure by way of the present amendment.

With regard to claim 2, the Examiner does not specifically support the rejection thereof as being anticipated by Komiya. With regard to claim 18, the Examiner argues that the same is obvious in view of Matsuno, arguing that it has been held that forming in one piece an article which has been formed in two pieces and put together involve only routine skill in the art (citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893)).<sup>1</sup>

However, such is not the case in the present circumstance. The apparatuses disclosed in the cited references are of the type in which clips are exchangeable. Therefore, they do not have a coupling member as do the clipping members recited in the independent claims of the present invention. In the clipping devices as recited in the claims, the clip can be separated from the top end of the coupling member by a pulling operation and the proximal end of the coupling member is connected to the operation wire. The clipping device of the present invention is intended for application to a disposable clip (which cannot be re-used) and a purpose of the clipping devices as recited in the claims is to eliminate a complicated process of exchanging of clips. None of the cited references discloses a clipping device which are configured to provide such benefits. Thus, the clipping devices as recited in the claims differ from those disclosed in the references in both objective achieved and structure.

To clarify this distinction, the term "fixed" in original dependent claims 2 and 18 has been changed to --connected--.

With regard to the rejection of claims 1, 2, 7, 8, 10, 17, 19 and 20 under 35 U.S.C. § 102(b), a clipping device having the features discussed above and as recited in independent claims 1 and 17, is nowhere disclosed in either Komiya or Matsuno. Since it has

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<sup>1</sup> Recent Federal Circuit and Supreme Court cases have held that the only determination under section 103 is whether the combination would have been obvious to those of ordinary skill in the relevant art at the time of the invention, which is conducted on a case-by-case basis. e.g., see In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., 1999) and In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., 1998).

been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>2</sup> independent claims 1 and 17 are not anticipated by either Komiya or Matsuno. Accordingly, independent claims 1 and 17 patentably distinguish over both Komiya and Matsuno and are allowable. Claims 7, 8, 10, 19 and 20 being dependent upon claims 1 and 17, are thus at least allowable therewith (claim 2 being canceled).

Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 1, 2, 7, 8, 10, 17, 19 and 20 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 3, 6, 9, 11-13, and 18 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 3, 6, 9, 11-13 are allowable therewith at least because they depend from an allowable base claim (claim 18 being canceled).

With regard to the rejection of claims 21-24 under 35 U.S.C. § 103(a), Independent claims 21-24, as amended, are not rendered obvious by the cited references because neither the Koyima patent, Matsuno patent nor the Jepson patent, whether taken alone or in combination, teach or suggest a clipping device having the features discussed above. Accordingly, claims 21-24, as amended, patentably distinguish over the prior art and are allowable.

Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 3, 6, 9, 11-13, 18 and 21-24 under 35 U.S.C. § 103(a).

Furthermore, new claims 25-27 have been added to further define the patentable invention. New claims 25-27 are fully supported in the original disclosure. Thus,

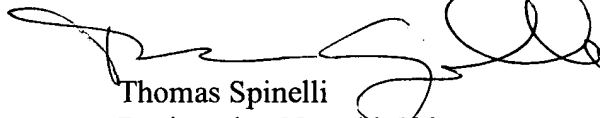
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<sup>2</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

no new matter has been entered into the disclosure by way of the addition of new claims 25-27. Applicants respectfully submit that new claims 25 and 26 are at least allowable as depending upon an allowable base claim (1 and 17, respectfully). Applicants further submit that independent claim 27 patentably distinguishes over the prior art and is allowable.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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